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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/732,991      | 12/11/2003  | John M. Sebastian    | 58624US002          | 1398             |

32692 7590 03/24/2006

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| EXAMINER |
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MATZEK, MATTHEW D

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

044

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/732,991 | <b>Applicant(s)</b><br>SEBASTIAN ET AL. |  |
|                              | <b>Examiner</b><br>Matthew D. Matzek | <b>Art Unit</b><br>1771                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The DiZio et al. reference (US 5,990,238) is directed to a release coating as opposed to a pressure sensitive adhesive, which is the invention instantly claimed by Applicant. Therefore, the finality of the rejection dated 1/11/2006 and the rejections set forth in the Office Action have been withdrawn. New grounds for rejection are as follows.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-16 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiZio et al. (US 6,455,152) in view of Renz et al. (US 6,187,845).

a. DiZio et al. teach an adhesive-coated article (Abstract) comprising woven, nonwoven, films, open weaves, and loose nonwoven webs (col. 7, lines 34-42). The substrate surface preferably has a web surface and may be made of polypropylene (col. 10, lines 4-19). The adhesive may be a pressure-sensitive adhesive (PSA) such as silicones (col. 1, lines 60-64). The adhesive may contain one or more PSA resins, cross-linking agents, and UV stabilizers (col. 7, lines 53-67). The PSA is applied to a major surface of the substrate and has a release liner (col. 3, lines 20-47). However DiZio et al.

is silent as to the use of an ultraviolet absorber and the specific composition of the pressure sensitive adhesive.

- b. Renz et al. teach pressure sensitive adhesive compositions that are rendered stable against ultraviolet (UV) degradation via the incorporation of benzotriazole UV absorbers (Abstract and col. 4, lines 24-35). The adhesive compositions may be used to protect interior structures, textiles, and fabrics (col. 3, lines 40-43). Claim 11 recites that the adhesive composition may contain between 0.1 to 20 weight percent of benzotriazole. The adhesive composition may additionally contain up to another 20% of another UV absorber, hindered amines, or conventional stabilizers (col. 13, lines 19-45). Additional adhesives may be added to the pressure sensitive adhesive composition (col. 20, line 57 – col. 22, line 26).
  - d. Since DiZio et al., and Renz et al. are all from the same field of endeavor, (i.e. pressure sensitive adhesive coated nonwoven articles), the purposes disclosed by Renz et al. would have been recognized in the pertinent art of DiZio et al.
  - e. It would have been obvious at the invention was made to a person having ordinary skill in the art to have made the article of DiZio et al. with the composition of Renz et al., motivated by the desire to create an article that provides excellent stabilization (col. 2, lines 34-41; Renz et al.).
3. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiZio et al. (US 6,455,152) in view of Romanowski (US 2004/0071916) and Renz et al. (US 6,187,845).
- a. DiZio et al. teach an adhesive-coated article (Abstract) comprising woven, nonwoven, films, open weaves, and loose nonwoven webs (col. 7, lines 34-42). The

substrate surface preferably has a web surface and may be made of polypropylene (col. 10, lines 4-19). The adhesive may be a pressure-sensitive adhesive (PSA) such as silicones (col. 1, lines 60-64). The adhesive may contain one more PSA resins, cross-linking agents, and UV stabilizers (col. 7, lines 53-67). The PSA is applied to a major surface of the substrate and has a release liner (col. 3, lines 20-47). However DiZio et al. is silent as to the type of nonwoven material to be used as backing in the adhesive tape, the use of an ultraviolet absorber and the specific composition of the pressure sensitive adhesive.

b. Romanowski teaches a nonwoven pressure sensitive adhesive tape comprising a nonwoven fabric layer (Abstract and [0062]). Nonwoven fabrics include spunbonded, needle punched (needletacked), and spunlaced fabrics [0062].

c. Renz et al. teach pressure sensitive adhesive compositions that are rendered stable against ultraviolet (UV) degradation via the incorporation of benzotriazole UV absorbers (Abstract and col. 4, lines 24-35). The adhesive compositions may be used to protect interior structures, textiles, and fabrics (col. 3, lines 40-43). Claim 11 recites that the adhesive composition may contain between 0.1 to 20 weight percent of benzotriazole. The adhesive composition may additionally contain up to another 20% of another UV absorber, hindered amines, or conventional stabilizers (col. 13, lines 19-45). Additional adhesives may be added to the pressure sensitive adhesive composition (col. 20, line 57 – col. 22, line 26).

d. Since DiZio et al., Romanowski and Renz et al. are all from the same field of endeavor, (i.e. pressure sensitive adhesive coated nonwoven articles), the purposes

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disclosed by Romanowski and Renz et al. would have been recognized in the pertinent art of DiZio et al.

e. It would have been obvious at the invention was made to a person having ordinary skill in the art to have made the article of DiZio et al. with the fabric of Romanowski, motivated by the desire to create a favorable flexible tape (Abstract; Romanowski), and the composition of Renz et al., motivated by the desire to create an article that provides excellent stabilization (col. 2, lines 34-41; Renz et al.).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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